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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/549,894

09/16/2005

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EXAMINER

ZEMEL, IRINA SOPJIA

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/549,894	Applicant(s) STANJEK ET AL.	
	Examiner Irina S. Zemel	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14-27 and 31-22 of copending Application No. 10/468633. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter of the instant application substantially overlaps in scope with the subject matter of the referenced application in that both application claims substantially identical/overlapping prepolymers having identical alkoxysilane terminated groups, and claiming hydrocarbon blowing agent as the only species in the instant application and one possible species of the referenced application as, for example, per claim 17 of the referenced application, thus making the choice of the claimed blowing agents clearly

envisaged from the group of blowing agents claimed in claim 17 of the referenced application.

It is further noted that the claimed A^1-R^1 end groups of the instant claims are indistinguishable from the alkoxy groups of the alkoxysilyl chain ends when A^1 is oxygen and R^1 is an alkyl group, thus fully reading on the (OR^2) groups in the $SiR_z^1(OR^2)_{3-z}$ of the referenced co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-21 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/066532 to CONSORTIUM FUR ELEKTROCHEM IND, (hereinafter "Consortium") (of record, a US counterpart application 2004072921 is used as an English language equivalent of Consortium for specific references and examples.

The examiner regrets any inconvenience the wrong form paragraph (35 USC 102(c)) cited in the previous office action may have caused the applicants. The rejection of this office action is made non-final in view of such erroneous citation of the applicable statutory basis.

As discussed in the previous office action, Consortium discloses foamable compositions comprising isocyanate-free, alkoxy silane-terminated prepolymer, having silane end groups of the formula fully corresponding to the compound of the claimed formula [2] or prepolymer corresponding to formula [3], and (B) a blowing agent. See, for example, abstract and claims of US PGPub 2004072921. The reference further expressly discloses isocyanate-free composition based on those compounds. Among suitable blowing agents (B) hydrocarbons having 1-5 carbon atoms are expressly disclosed in claim 3 and [0032] as one possible blowing agents species in a group of only three species (that also includes dimethyl ether), and their mixtures, which makes the claimed hydrocarbon blowing agents clearly envisaged from the genus of only three species, as well as the mixture of two out of three species is also clearly envisaged from the disclosure of [0032]. The reference further expressly discloses a pressure vessel containing the foamable composition containing components A and B.

As noted above, the claimed A^1-R^1 end groups of the instant claims are indistinguishable from the alkoxy groups of the alkoxy silyl chain ends. When, for example, the claimed A^1 is oxygen and R^1 is an alkyl group of 2-20 carbon atoms, the claimed A^1-R^1 group fully reads on the (OR^2) groups in the $SiR^1_z(OR^2)_{3-z}$ of formula [1] as recited in the reference (and, for example, recited in claims 12 and 13). Therefore, in the absence of distinction between alkoxy groups of the alkoxy silyl and groups and the claimed A^1-R^1 groups, the reference is still considered to be anticipatory reference of the claimed invention.

The comparative examples are noted, however, they are irrelevant to the anticipatory rejection under 35 USC 102, claiming mixture *comprising* the two claimed components.

Response to Arguments

However, applicant's arguments filed 3-7-2008 with respect to the anticipatory rejection over '921 publication have been fully considered but they are not persuasive. As per discussion above, the claimed A1-R1 end groups are indistinguishable from alkoxy groups of the alkoxysilyl chain ends, thus, the cited reference is still considered to anticipate the claimed invention. While the applicants illustrate the claimed compound by a pre-polymer having dodecanoxy groups in addition to alkoxysilane groups, nowhere in the claims A¹-R¹ is required to be either devoid of silicon or to be a reaction product of an alcohol (or another functional monomer) with an isocyanate terminal group of the prepolymer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/
Primary Examiner, Art Unit 1796

Irina S. Zemel
Primary Examiner
Art Unit 1796

ISZ